



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,302	08/17/2001	Hennie Wesseling	BO44440ACW/S	6564
466	7590	10/03/2003	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 10/03/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,302

Applicant(s)

WESSELING ET AL.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 6/30/2003.
2. Claims 28-50 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 28-30, 32-35, 37-39, 41-45 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Feinberg (U.S. 6,082,776).

Re claims 28, 37, 48: Feinberg discloses storing personal medical information, which includes means of generating and storing a set of unique bit strings (see in Figs. # 12B-C of

Art Unit: 2876

Feinberg) in a first memory in a central office or the database 100 connected to a plurality of terminals (col.15, lines 50-67; col.16, lines 29-67; cols. 17-18); making available [via database 100] one or more of the unique bit strings [also known as a hash number made up with lengthy binary numbers up to 52 bits (see col.17, lines 1+), or alphanumeric characters based upon the computer-generated system and field] to one of the terminals (col.4, lines 17-22 and col.10, lines 56+); establishing an identification code/number 15 (col.5, lines 50+); transmitting data including a copy of the unique bit strings in combination with the identification code to the central office/database 100 (col.4, lines 17+), and storing the data in a second memory (col.8, lines 42+); generating a franking mark 19 [in the art could be considered as a printed matter such as a barcode (visible or invisible to the human eye), or any combination of alpha-numeric code, wherein an encoded security code is encrypted on a document such a money/legal tender, (ID, medical, insurance) card and the like] which at least includes information relating to one of the unique bit strings and the identification code (see fig. # 1A-C of Feinberg; col.6, lines 10+); securely printing (through printer 82) the franking mark on the document (col.2, lines 50+; col.7, lines 7+) in the machine readable format or barcode 19 (see Fig. # 1a-c of Feinberg).

Re claims 29, 38: Feinberg teaches a method, which includes means of protecting the unique bit string and the identification code with one of the aid of a first message authentication code [or password, PIN number] and by encoding (col.6, lines 38+; col.21, lines 5-67; col.24, lines 27+); and storing the unique bit string and the identification code 20 by a terminal on an information carrier [or a smart card as disclosed into the teachings of Feinberg as an alternative for the card 10 with more storage capabilities] with memory (col.7, lines 5+).

Re claims 30, 39: Feinberg discloses a method, wherein in addition to the unique bit string and the identification code, storing a terminal identification code, protected with one of the aid of the first message authentication code and by encoding, on the information carrier with memory by the terminal (col.7, lines 6+).

Re claims 32, 41, 49: Feinberg discloses a method, wherein after reading the information carrier 10, it is checked whether the value of a counter on the information carrier lies within predefined limits, and if this the case, the value of the counter is adjusted after reading and step f is executed, and if this is not the case, step f is blocked (col.21, lines 12-63).

Re claims 33, 42: Feinberg teaches a method, wherein upon execution of step f (from claim 28), use is made of a computer 54 and a printing device 82, 84 connected thereto (see Figs. # 2-3 of Feinberg; col.7, lines 1-67).

Re claims 34, 44: Feinberg discloses a method, wherein the identification code comprises at least one of a user identification code [wherein by deciphering the code one would know if the user/patient is a male or female, age group and the like] and a printer identification code (col.15, lines 32-67).

Re claims 35, 45: Feinberg teaches a method, wherein on the basis of the franking mark calculating a second message authentication code and printing in encode format at least one of the second message authentication code [unique personal information related to the user and enable to authenticate the mark] and the franking mark (see figs. # 1A-C of Feinberg; col.21, lines 65-67; col.22, lines 1-7).

Re claim 43: Feinberg discloses a method and system, wherein the system is provided with means arranged remotely from the computer to send the unique but string, together with the

Art Unit: 2876

identification code, protected by at least one of a message authentication code and encoding, to the computer and to send data to the central office (see Fig. # 5 of Feinberg; col.7, lines 20+).

Re claim 50: Feinberg teaches a system and method, which includes an information carrier in the form of a card 10, provided a memory which at least contains the following data: a unique bit string selected from a set of unique bit strings (see Fig.# 12 B-C of Feinberg; col.15, lines 50+; and cols.16, 17 and 18) an identification code and a message authentication code which is calculated on the basis of the unique bit string (col.17, lines 17+) and at least one of the identification code and the identification code in the encoded form (col.7, lines 6+).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 31, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg (U.S. 6,082,776) in view of Lee et al. (U.S. 6,170,744).

The teachings of Feinberg have been discussed above.

Feinberg fails to disclose a method wherein after reading the information carrier, use of the unique bit string for printing a further mark is rendered impossible by the printing device.

Lee et al. discloses self-authenticating negotiable documents, which includes a method for providing a secure non-reusable one-way hash value 120(as shown in fig. # 1o Lee et al.; col.6, lines 5-65 and col.11, lines 26+).

Art Unit: 2876

In view of Lee et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Feinberg a means [which could be done by modifying the software so as to include a subroutine that will implement an error or to stop the process if the unique bit string/hash value is read and/or printed twice] of using the unique bit string for printing a further franking mark after reading the information carrier so as to prevent cloning/reproduction of the unique bit string/hash value for producing forgery/falsified document. Furthermore, such improvement will reassure the authenticity of the unique bit string/hash value [wherein personal information could be included and used for tampering] and the legitimacy of the document(s) onto which the franking mark is printed, and provide more security for all personal information encoded into the code/bit string. Moreover, such modification would have been an obvious extension as taught by Feinberg, therefore an obvious expedient.

8. Claims 36, 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg (U.S. 6,082,776).

The teachings of Feinberg have been discussed above. Moreover Feinberg also discloses a first memory (from the computer 54), a second memory (from the card 10, which could from the smart card, the magnetic stripe or the like), that which includes a software to retrieve and match data (col.7, lines 29+).

Feinberg fails to teach a third memory for storing combinations of identification code and unique bit strings and means of comparing the read-in frank marks (from the third memory) to the data in the second memory.

Art Unit: 2876

However, since the system is required to store the unique bit string on one more storage locations, the specific structure with different memory locations and quantity is obtained and also falls within the engineering design variation.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Feinberg a third memory in order to store combinations of identification code and unique bit strings and means of comparing the read-in frank marks (from the third memory) to the data in the second memory. Furthermore, such modification would ensure the authenticity of identification code and unique bit strings and provide other means to detect any fraudulent activity on the document wherein the identification code and unique bit strings is stored on other locations. Moreover, such modification would have been an obvious extension of the teaching of Feinberg.

Response to Arguments

9. Applicant's arguments with respect to claims 28-50 filed on 6/30/2003 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chapman (U.S. 5,432,506) discloses counterfeit document detection system.

Guski et al. (U.S. 5,661,807) teaches authentication system using one-time passwords.

Gibbs et al. (U.S. 6,085,321) discloses unique digital signature.

Art Unit: 2876

Franklin et al. (U.S. 6,000,832) teaches electronic online commerce card with customer generated transaction proxy number for online transactions.


Seysen (U.S. 6,405,923) discloses method for secure distribution of data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
September 16, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800